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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,

Plaintiff,

v.

VYSIS, INC.,

Defendant.

No. 99cv2668 H (AJB)

**DECLARATION OF STEPHEN P. SWINTON IN  
SUPPORT OF GEN-PROBE INCORPORATED'S  
MOTION FOR LEAVE TO FILE SECOND  
AMENDED COMPLAINT**

Date: February 20, 2001  
Time: 10:30 a.m.  
Dept.: Courtroom 1

I, Stephen P. Swinton, declare as follows:

1. I am an attorney at law, licensed to practice before the Courts of the State of California and admitted to practice before this Court. I am a partner in the law firm Cooley Godward LLP, counsel of record for Plaintiff Gen-Probe Incorporated ("Gen-Probe"). I am lead trial counsel for Gen-Probe, and I have been substantially involved in the preparation of this matter for trial. If called as a witness in this matter, I could and would competently testify to the matters set forth below:

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1 2. Gen-Probe filed the initial Complaint in this action on December 22, 1999. On  
2 January 26, 2000, before Vysis responded to that pleading, Gen-Probe filed its First Amended  
3 Complaint. Although Gen-Probe suspected that there existed a factual basis to allege a cause of  
4 action for inequitable conduct at this time, Gen-Probe was not then in possession of sufficient facts  
5 to plead such a cause of action with the required particularity. A true and correct copy of the First  
6 Amended Complaint is attached hereto as Exhibit 1.

7 3. On February 3, 2000, Gen-Probe propounded to Vysis Gen-Probe's First Set of  
8 Requests for Production of Documents to Vysis, Inc. ("Document Requests"), a true and correct  
9 copy of which is attached hereto as Exhibit 2. When Gen-Probe propounded these document  
10 requests, it believed that the requests might unearth documents necessary to confirm that Vysis  
11 engaged in inequitable conduct before the patent office.

12 4. On March 8, 2000, Gen-Probe propounded document subpoenas (the "Subpoenas")  
13 to BP Amoco, Thomas Banks, Norval Galloway, and Finnegan, Henderson, Farabow, Garrett and  
14 Dunner LLP ("Finnegan, Henderson") (collectively the "Third Party Witnesses"). For the most  
15 part, the categories of documents sought by the subpoenas were identical the categories of  
16 documents sought by Gen-Probe's Document Requests to Vysis. Gen-Probe believed that the  
17 Third Party Witnesses possessed documents relevant to the prosecution of United States Patent No.  
18 5,750,338 (the "'338 patent"), which is the patent-in-suit.

19 5. On March 8, 2000, notwithstanding its prior statements to Gen-Probe that Vysis  
20 was satisfied with the claims of the '338 patent, Vysis filed a request for reissue of the '338 on the  
21 admitted grounds that the patent was "defective."

22 6. On March 9, 2000, Vysis filed a motion encaptioned Motion by Vysis, Inc. For A  
23 Stay Of Proceedings And, Alternatively, To Dismiss Count Four Of The First Amended Complaint  
24 Under Federal Rule of Civil Procedure § 12(b)(6) ("Motion to Stay"), where Vysis asserted that  
25 the litigation should be stayed pending the conclusion of the reissue proceeding that Vysis had  
26 initiated the day prior.

27 7. In or about March 2000, the parties stipulated to suspend temporarily their  
28 discovery efforts, pending the resolution of the Motion to Stay.



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1 depositions were to be held in late October 2000. Gen-Probe believed that the information it  
2 would gather during these depositions would help to confirm its suspicions that Vysis had engaged  
3 in inequitable conduct with respect to the '338 patent.

4 17. Several days in advance of the Rule 30(b)(6) Patent Prosecution Depositions, per  
5 Gen-Probe's request, Vysis produced to Gen-Probe files it had maintained with respect to the  
6 prosecution of several patent applications related to the '338 patent.

7 18. On October 26 and 27, 2001, Gen-Probe deposed Vysis and BP Amoco's 30(b)(6)  
8 designee on the prosecution of the '338 patent, Norval Galloway. During the Rule 30(b)(6) Patent  
9 Prosecution Depositions, Gen-Probe for the first time learned certain facts contained in the  
10 [Proposed] Second Amended Complaint, and confirmed other facts contained therein.

11 19. Although Gen-Probe learned additional facts to support its allegations of  
12 inequitable conduct during the Rule 30(b)(6) Patent Prosecution Depositions, Gen-Probe  
13 determined that it would be appropriate to defer seeking leave to amend until after Vysis produced  
14 all of the documents responsive to the Document Requests and the Third Party Witnesses produced  
15 all of the documents responsive to the Subpoenas.

16 20. In mid-November and early December 2000, Vysis produced to Gen-Probe  
17 approximately 100,000 pages of documents.

18 21. Gen-Probe immediately undertook to review these documents and completed its  
19 initial review of those documents in early January 2001.

20 22. On January 16, 2001, Vysis produced an additional eight banker's boxes of  
21 documents, which boxes contain approximately 20,000 additional pages of responsive documents.

22 23. Vysis has not yet noticed or taken any depositions in this matter.

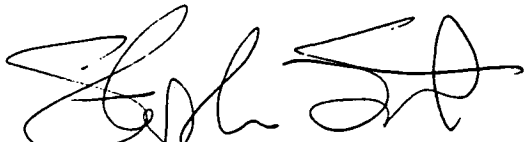
23 24. Attached hereto as Exhibit 5 is a true and correct copy of the Scheduling Order  
24 issued in this matter.

25 25. Attached hereto as Exhibit 6 is a true and correct copy of a Declaration Norval  
26 Galloway, which Vysis filed earlier in this case, wherein Mr. Galloway states that he is Vysis'  
27 primary in-house patent prosecution attorney and that he possesses detailed knowledge about the  
28 patent-in-suit.

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26. Attached as Exhibit 7 to this Declaration is the original copy of Gen-Probe's [Proposed] Second Amended Complaint.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct and that I executed this declaration in San Diego, California on January 19, 2001.



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Stephen P. Swinton

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